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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,508

08/25/2003

Frank T. Brzozowski

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44321

7590

03/24/2005

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EXAMINER

MAI, HUY KIM

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/648,508

Applicant(s)

BRZOZOWSKI, FRANK T.

Examiner

Huy K. Mai

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 39-42 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-29, 34-38, 43 and 44 is/are rejected.
- 7) ☒ Claim(s) 30-33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/26/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. The election, Group II, claims 19-38,43,44 is acknowledged.
2. Claims 1-18,39-42,45 are withdrawn from consideration as directed to non-elected invention.
3. Claims 19-38,43,44 will be examined as follows:

Information Disclosure Statement

4. The information disclosure statement (IDS) filed Nov. 26, 2003 is acknowledged.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23,34,36,37,43,44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations "said at least one lens further comprising at least one peripheral member" (claim 23, lines 2-3) is inaccurate because the peripheral member is not a part of the lens. The lens is attached to the peripheral member. Similarly, at least one rotator and at least one memory member are not parts of the lens; therefore, the limitations "said lens comprised of at least one rotator" (claim 34, lines 1-2), "said lens further comprising a peripheral member" (claim 36, lines 1-2) and "said lens further comprising at least one memory member" (claim 37, lines 1-2) are inaccurate.

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The phrase “said system further comprising a bezel portion” (claim 43, line 18) should be expressed in a better phrase –said lens member further comprising a bezel portion--. The phrase “said bezel” (claim 43, line 24, both occurrences; and line 29) should read –said bezel portion--; otherwise, it is unclear, the applicant intend to be “said bezel stop member” or “said bezel portion”? Similarly, the phrases “said rim” (claim 43, line 30) and “said rim stop” (claim 43, line 32) should read –said rim portion--, and –said rim stop member--, respectively. The phrase “said eyeglass system” (claim 44, line 4) has no antecedent basis.

Regarding claim 44, the phrase “*or the like*” renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by “or the like”), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d).

Regarding claim 44, the phrase “*consisting essentially of ...*” was held to be definite because the specification contains guidelines that were considered sufficient to enable a person of ordinary skill in the art to draw a line between unavoidable impractical in using the rotatable lens in the air such as airplane pilot eyewear and essentially using deep in the sea such as deep sea diving eyewear as claimed. In re Marosi, 710 F.2d 799, 218 USPQ 289 (CCPA). The court further observed that it would be impractical to require applicant to specify a particular number as a cutoff between their invention and the prior art.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 19,20,22-24,34-37,44 are rejected under 35 U.S.C. 102(b) as being anticipated by Stewart (1,735,021).

The limitations in claims 19,20,22-29 are shown in Stewart's Figs. 1-2, columns 1-2. Stewart discloses an eyewear comprising at least one containment structure 1 and at least one lens 2 being rotatable within said containment structure 1, said eyewear further comprising at least one rotator 5, said at least one lens being rotatable at least by said rotator 5.

Regarding claim 20,22-24,34-37, Stewart discloses the eyewear comprising at least one turning member 5 attached to the peripheral member 4, and at least one containment stop member 6,7 wherein the peripheral member 4 engaging with the peripheral edge of the lens.

Regarding claim 44, Stewart discloses an eyewear comprising at least one containment structure 1 and at least one lens 2, said at least one lens being rotatable within said containment structure, said eyewear further comprising at least one rotator 5, said at least one lens being rotatable at least by said rotator 5, wherein said at least one lens can be attached to a containment structure contained in a group of headwear consisting essentially of eyeglasses.

9. Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Werling, Sr. (3,826,564).

Werling, Sr., in Fig. 3, discloses an eyewear lens comprising an anchor cut-out 27.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 21,43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart in view of Morrison (5,459,534).

Stewart discloses the claimed invention as discussed above, except for the lens member 4 slidably coupled to the rim portion 1 instead of a bezel portion of the lens slidably coupled to the rim portion as claimed by the applicant. Morrison discloses a bezel portion of the lens slidably coupled to the rim portion for the purposes of rotating the lens within the rim portion. Since Stewart and Morrison are both from the same filed of endeavor, the purpose disclosed by Morrison would have been recognized in the pertinent art of Stewart. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the Stewart's eyewear in light of Morrison's teachings for the same purpose of rotating the lens within the rim portion as disclosed by Morrison as the applicant does.

Allowable Subject Matter

12. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 31-33 are objected to as being dependent upon the above objected claim.

14. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose the limitations of said eyewear system further comprising at least one memory member, said lens being rotatable at least by said memory member, as claimed. Therefore, these limitations could be allowable over the prior art of record.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Huy Mai
Primary Examiner
Art Unit 2873

HKM/
March 20, 2005